



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/480,520 01/07/00 ANDERSEN

D DLL627

┌

MM91/0417

EXAMINER

KAARDAL & ASSOCIATES PC
IVAR M KAARDAL
3500 SOUTH FIRST AVE CIRCLE
SUITE 250
SIOUX FALLS SD 57105-5807

GONZALEZ, M	
ART UNIT	PAPER NUMBER

2859

DATE MAILED:

04/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/480,520

Applicant(s)

ANDERSEN, DEREK

Examiner

Madeline Gonzalez

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because of the following informalities:
 - a) "stud marking device includes includes" in line 6 of the abstract should be replaced with --stud marking device includes--.

Correction is required. See MPEP § 608.01(b).

Claim Objections

2. Claim 4 is objected to because of the following informalities:
 - a) "removeably" in line 4 should be replace with --removably--.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson (U.S. 4,377,850) in view of Dunn (U.S. 4,176,458) and Kaufman (U.S. 5,416,978).

Art Unit: 2859

Simpson discloses a measuring device, as shown in Fig. 1, having:

- a handle 36 including a calculating unit 11 (tubular base member),
- a pair of brackets 13 and 14 (prong-like members) spaced apart and extending from a bottom end thereof,
- a roller 15 (wheel) rotatably mounted to said calculating unit 11 (base member) and being extended between said pair of brackets 13 and 14 (prong-like members),
- said calculating unit 11 (base member) further includes a pair of recesses 30 and 31 (slots) each of which extends in a bottom end of a respective one of said brackets 13 and 14 (prong-like members),
- said calculating unit 11 (base member) includes an extended portion extending outwardly from said pair of brackets 13 and 14 (prong-like members) and including a housing 12,
- said calculating unit 11 (base member) includes a keyboard (keypad) and a display, and
- said roller 15 (wheel) having a plurality of undulations 16 (rib-like members) spacedly disposed upon one side of said roller 15 (wheel).

The recitation “a stud marking device” in the preamble of the claims, has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. See *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

Simpson lacks three telescopic members, means for marking locations including a marker threaded in a bore, and the specific space between the rib-like members.

With respect to the three telescopic members: Dunn discloses a distance measuring apparatus having a handle element 12 (first tubular member) having a plurality of holes 20 spaced therealong and extending through a wall thereof, said handle element 12 (first tubular member) being slidably and lockingly extended in a handle element 14 (base member). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the handle in the device disclosed by Simpson with telescopic members as taught by Dunn in order to provide means for adjusting the handle to different extended positions to reach a desired placed for making a measurement. Furthermore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide more telescopic members in order to increase the length of the handle and reach far places, since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. See *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

With respect to the means for marking locations including a marker threaded in a bore: Kaufman discloses a marking device 10 as shown in Fig. 7, having means for marking a location including a spring loaded-marker 44 disposed within a housing 12 and is adaptable to extend and retract within an opening 16 (bore). Kaufman teaches a mechanism that operates as follows: when a first engaging member 24 passes over a shaft 70, a linkage mechanism is activated and

Art Unit: 2859

the marker 44 is released. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention as made to modify the device disclosed by Simpson as modified by Dunn with a marking means as taught by Kaufman in order to provide a way of marking the specific distance measured.

With respect to the specific space between the rib-like members: Simpson as modified by Dunn and Kaufman disclose a measuring device having a roller (wheel), said roller (wheel) having a plurality of undulations 16 (rib-like members) spaced at some distance. The specific spaced claimed by applicant, i.e., approximately one inch, absent any criticality, is only considered to be the "optimum" spaced of the rib-like members disclosed by Simpson as modified by Dunn and Kaufman that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy, manufacturing costs, etc. See In re Boesch, 205 USPQ 215 (CCPA 1980).

5. Claims [§] 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson (U.S. 4,377,850) in view of Dunn (U.S. 4,176,458) and Kaufman (U.S. 5,416,978) as applied to claims 1-10, 12 and 13 above, and further in view of Edgar et al. (U.S. 5,884,240) [hereinafter Edgar].

Art Unit: 2859

Simpson (U.S. 4,377,850) in view of Dunn (U.S. 4,176,458) and Kaufman (U.S. 5,416,978) disclose all the subject matter claimed above in paragraph 4 with the exception of and LCD display, a microcontroller, and LCD driver, and IR transmitter and an IR receiver.

With respect to the LCD display and the microcontroller: Edgar discloses an apparatus, as shown in Fig. 1, having an on-board computer module 44, said computer including a LCD display (see col. 30, lines 3-6), a microcontroller including read only memory (see col. 26, lines 34-38), a line driver / receiver (see col. 7, lines 32-35) and a transmitter (see col. 3, lines 52-54). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the calculator unit in the device disclosed by Simpson as modified by Dunn and Kaufman with a computer as taught by Edgar in order to have means for storing the data when the device is used for making measurements.

With respect to the specific type of driver, transmitter and receiver: Simpson as modified by Dunn, Kaufman and Edgar disclose a measuring device having a line driver / receiver and a transmitter. The specific type of driver, transmitter and receiver claimed by applicant, i.e., and LCD driver an IR transmitter and an IR receiver, absent any criticality, are only considered to be nothing more than a choice of engineering skill, choice or design because LCD drivers, IR transmitters and IR receivers are well known in the art and neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as a driver, a transmitter and a receiver are used as already suggested by Simpson as modified by Dunn, Kaufman and Edgar.

Art Unit: 2859

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nosek discloses an apparatus for measuring distances having a plurality of telescopic members. Pickard discloses a measuring device having a base member with a pair of prong-like members and a wheel. Hall discloses a measuring apparatus having markings on the wheel equally spaced. Kubo discloses a marking device having a calculating device. Houck, Heagerty and Angilella et al. ('846) disclose devices having a marker.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeline Gonzalez whose telephone number is (703) 308-7004. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703) 305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

MG
April 11, 2001



Diego F.F. Gutierrez
Supervisory Patent Examiner
Technology Center 2800